

R E M A R K S

Favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

The current amendment proposes to limit the fuel hose of claim 1 to one which consists essentially of the inner single layer of a fluororesin and the outer single layer of a thermoplastic resin. As this subject matter has been before the Examiner from the filing of the application, no new issue is involved. The proposed amendment to claim 2 limits the fuel hose to one in which the sole essential components are the inner single layer of a fluororesin and the outer single layer of a thermoplastic resin. As indicated with respect to the proposed amendment to claim 1, this subject matter as well has been before the Examiner from the time the application was filed. Once more, no new issue is involved.

The rejection of claims 1 to 4, 14, 18 and 19 "under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al..." is respectfully traversed. Yamamoto solves the problem addressed and solved by Applicants solely by providing a laminate comprising a three-layer structure having a composition layer as an intermediate layer between an inner fluororesin layer and an outer polyamide resin layer. This is submitted to be a teaching away from Applicants' claimed invention. Yamamoto does not disclose or suggest being able to achieve uniformity in wall thickness or avoiding a decrease in adhesive strength between the layers in the manner disclosed and claimed by Applicants. In this regard reference is respectfully made to the first complete paragraph on page 2 of the specification, as well as the paragraph bridging pages 2 and 3. Reference is also made with the penultimate sentence on page 3 of the specification.

Issue is respectfully taken with the unsupported and unsupportable allegation:

Yamamoto et al therefore disclose a ratio of melt viscosity of the inner to the outer layer ranging between $1:1 \times 10^{-4}$ and $1:1 \times 10^4$, which includes 1:40.

A reference disclosure that is generic to or suggestive of a claimed product does not preclude patentability of the product if the product possesses one or more significant properties that are not shared by its closest counterpart(s) within the disclosed or suggested genus, or if the claimed product is significantly better (with regard to a material property) than its closest counterpart(s) within the disclosed or suggested genus. *In re Ruschig, Aümuller, Korger, Wagner, Scholz, and Bänder*, 145 U.S.P.Q. 274, 281, 283 (CCPA 1965).

The selection of the ratio of total jaw length to the average jaw height and the narrow range of hardness claimed is not a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made. It is axiomatic that not only must claims be given their broadest reasonable interpretation consistent with the specification, but also all limitations must be considered. Here the characterization of certain specific limitations or parameters as obvious does not make the appellant's invention, consideration as a whole, obvious. The fact that the invention may have been the result of experimentation does not negate patentability nor render obvious claimed parameters that are the result of experimentation. *Ex Parte Petersen*, 228 U.S.P.Q. 216, 217 (BPAI) 1985.

When a claimed invention is not identically disclosed in the reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q. 2d 1913, 1928 (Tenn. 1988), *Aff'd*, 13 U.S.P.Q. 2d 1956 (Fed. Cir. 1989).

The generic diphenol formula disclosed in the reference relied upon contains a large number of variables (including, perhaps, more than 100 million different diphenols, only one of which is that called for by appellant's claim). While the reference formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the reference disclosing or suggesting that one should select such variables. Indeed, the reference appears to teach away from the selection of bisphenol A by focusing on more complex diphenols. The Board clearly erred in finding that the reference would have provided the requisite motivation for the selection of bisphenol A in the preparation of the claimed compounds. *In re Baird*, 29 U.S.P.Q. 2d, 1550, 1552 (Fed. Cir. 1994).

This rejection is based on alleged anticipation. Yamamoto does not present any embodiment within the scope of any of Applicants' claims. There is no anticipation here. Applicants' disclosure points out that his limitation in the range of melt viscosity achieves two unexpected results: it retains adhesive strength between the layers and achieves uniformity in wall thickness which is otherwise lacking.

In addition to the foregoing, reference is made to what "would have been obvious for one of ordinary skill in the art" with regard to claims 5 and 6. Since the rejection is based on anticipation, reference to "obviousness" is submitted to be inappropriate.

In paragraph 8 of the Office Action of March 30, 2004, reference is made to a "new 35 U.S.C. 103(a) rejection"; however, no such rejection appears in the preceding text on pages 2 to 7 of the Office Action. If the intent was to present a new ground of rejection based on Yamamoto under 35 U.S.C. 103(a), that would be a new ground of rejection in an Office Action that was made final, thus making the finality of the Office Action premature. In any event, the finality of that Office Action is thus inappropriate, and its withdrawal is in order and is respectfully solicited.

The rejection of claims 7 to 9 "under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al... in view of Yokoe et al..." is also respectfully traversed. In this connection, reference is respectfully made to the sentences bridging pages 2 and 3 of the specification:

...an electrically conductive material, such as a carbon black, or metal powder, is sometimes added to an inner layer of a fluororesin for a fuel hose to prevent sparking. In such a case, the fluororesin has a still higher melt viscosity making a still greater difference from that of e.g. a polyamide resin. The problems as pointed out above are, therefore, still more serious.

The foregoing has apparently been inadvertently overlooked when the corresponding text of Yokoe was combined with Yamamoto.

The rejection of claims 10 to 13, 15, 17 and 21 "under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al... in view of Spohn..." is also respectfully traversed. Spohn actually teaches away from Yamamoto by providing an alternative means of adhering the respective layers by use of an adhesive activation of at least one of the co-extruded polymers.

The rejection of claim 16 "under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al... in view of Murakami et al..." is also respectfully traversed. Since Yamamoto achieved desired adhesion by providing an intermediate layer, there would be no need for him to "increase the interlaminar adhesion strength", based on Murakami. In the event that any further reliance is placed on Murakami, Applicants request an English translation of the entire disclosure of that reference, rather than merely an abstract.

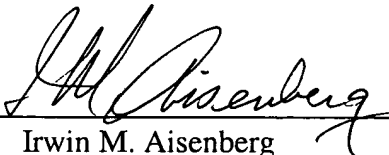
The rejection of claim 20 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al... in view of Stanley..." is also respectfully traversed. The reliance upon Stanley is a prime example of retrospective reconstruction based on Applicants' own teachings. Nothing is found in

either reference that would lead to any combination of any particular teachings of either with any particular teachings of the other.

Entry of the preceding amendments and allowance of all of Applicants' claims are now in order and are respectfully solicited.

Respectfully submitted,

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